

USSN: 09/838,884

Attorney Docket No.: 117-P-1345US11

Remarks

A cross-reference claiming the benefit of Application Serial No. 09/301,164, filed April 28, 1999 has been inserted at page 1. The '164 application is a prior-filed copending nonprovisional application naming at least two inventors (*viz.*, Bryan M. Anderson and Keith E. Olson) named in the present application. The entire delay between the date the claim was due to be filed under 37 C.F. R. §1.78(a)(2)(ii) and the date this claim is being filed was unintentional. Please charge the \$1380.00 fee required under 37 C.F. R. §1.17(t) to Deposit Account No. 50-0549.

Claim 34 has been editorially amended. Following entry of this amendment, claims 1 – 35 will be pending, with claims 1 – 27 having been withdrawn from consideration.

This amendment is accompanied by a Declaration of Robert D. P. Hei Under 37 C.F.R. §1.132. Applicants thank the Examiner for extending an in-person interview to the undersigned attorney and Dr. Hei on May 13, 2004. The Examiner's Interview Summary dated May 13, 2004 and the Declaration collectively summarize the substance of the interview.

Rejection of Claims 33 – 35 under 35 USC §102(b)

Claims 33 – 35 were rejected under 35 USC §102(b) as being anticipated by Published PCT Application No. WO 94/22965 (Koreltz et al.). Applicants previously argued that:

"Claims 33-35 recite a step of applying a strip agent to a dried waterborne "radiation cured" overcoat adhered to a dried intermediate layer atop a substrate, and a step of "removing ... the overcoat without removing substantial portions of the underlying substrate". Koreltz et al. describe compositions for stripping "standard floor finishes and/or greasy residues from hard surfaces such as floors" (see, e.g., page 1, lines 5-8 and page 3, line 35 through page 4, line 2, emphasis added), but do not show removing a radiation cured overcoat. Radiation cured (e.g., UV cured) coatings are not "standard" finishes, and are very difficult to strip." (see the January 12, 2004 Amendment at page 3).

In response, the Office Action asserted that:

"Applicants traverse the rejection of claims 33-35 under 35 U.S.C. 102(b) as being anticipated by Koreltz et al. (WO 94/22965) and submit that the overcoat layer taught by Koreltz is not radiation cured and therefore is much more difficult to strip than the

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'standard' coatings taught by Koreltz. Applicants further state that Koreltz's working examples use CITATION finish that does not contain a photoinitiator and is not radiation cured.

"First, the Examiner would like to point out that the coated samples in the working examples disclosed by Koreltz are prepared by coating the substrate with the sealant/finish and then heating in an oven to obtain a fully hardened coating thus indicating that the coatings are cured. Second, the Examiner would like to point out that the cured coatings of Koreltz are equivalent to the cured overcoat of the claimed invention given that claims 33-35 are directed to "a method of removing a multilayer laminate comprising: a) applying a strip agent to a dried waterborne radiation cured overcoat adhered to a dried intermediate layer atop a substrate" and hence the claims require that the overcoat be cured – the fact that the overcoat was applied as a waterborne composition and then radiation cured is simply the process by which the cured overcoat layer was obtained." (see the Office action at page 5, numbered paragraph 4)

Applicants request reconsideration. The Declaration shows that tests of a Koreltz et al. stripper using Koreltz et al.'s 2.5 minute dip test did not remove a UV-cured waterborne overcoat whether applied as a single layer or in a laminate finish. Koreltz et al. do not show the invention claimed in claims 33 – 35.

Applicants note for the record that they do not intend that their response to the Office Action should or would redefine or otherwise alter the manner in which the legally significant terms "doctrine of equivalents" or "equivalent" might affect the interpretation or enforcement of their eventual patent claims. The Office Action appears to have used the term "equivalent" to mean "not having novelty" within the context of a 35 U.S.C. §102(b) rejection.

Applicants request that the rejection of claims 33 – 35 under 35 USC §102(b) be withdrawn.

Rejection of Claims 28 – 32 under 35 USC §103(a)

Claims 28 – 32 were rejected under 35 USC §103(a) as being unpatentable over Published PCT Application No. WO 98/11168 (Hamrock et al.) in view of U.S. Patent No. 6,444,134 B1 (Holman et al.). The Office Action asserts that:

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"it would have been obvious to one having ordinary skill in the art to replace the radiation curable coating comprising a polyfunctional isocyanurate and a hydroxyalkyl acrylate, as taught by Hamrock et al., with a water based finish including urethane and acrylic polymers and copolymers and crosslinking agents given that Holman et al. specifically teach that such water-borne coatings exhibit high hardness, flexibility, UV resistance, chemical resistance and abrasion resistance." (see the Office action at page 4, numbered paragraph 3)

Applicants request reconsideration. The Declaration explains that Hamrock et al. do not disclose a waterborne overcoat as is recited in claims 28 – 32. The Declaration also explains why a person having ordinary skill in the floor finish art who consulted Hamrock et al. would find reasons **not** to use a waterborne overcoat in Hamrock et al.'s system.

As also explained in the Declaration, Holman et al. do not describe finishes like those described by Hamrock et al., and do not relate to strippable finishes. Holman et al.'s renewal finish is said to have "chemical resistance". The Declaration explains that a person having ordinary skill in the floor finish art who consulted Holman et al. would not use Holman et al.'s renewal finish where strippability was desired. Chemical resistance is **contrary** to strippability and a reason **not** to use Holman et al.'s renewal finish. It is also a reason **not** to use Holman et al.'s renewal finish in place of Hamrock et al.'s radiation curable overcoat.

As also explained in the Declaration, 100% solids radiation curable coatings like those described by Holman et al. may have poor spreading or coating characteristics. Some 100% solids radiation curable coatings tend to have a high viscosity and a ridged surface appearance after cure. Such a ridged surface would be unacceptable to end users. 100% solids radiation curable coatings may also be formulated using lower viscosity monomers to reduce the coating viscosity and thereby discourage ridge formation. However, if applied atop a strippable intermediate coating, the cured coating tends to have very uneven gloss (referred to as "diving" and possibly caused by an attack by low viscosity monomers in the topcoat upon the hardened undercoat). A laminate finish that exhibited diving would be unacceptable to end users.

Applicants' claim 28 – 32 methods are not shown or suggested by Hamrock et al.'s system and its 100 % solids radiation curable topcoat or by Holman et al.'s chemically resistant

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wood floor renewal finish. Applicants request withdrawal of the rejection of claims 28 – 32 under 35 USC §103(a).

Conclusion


Applicants have submitted a Declaration directed to the rejections and have made an earnest effort to place the application in condition for allowance. Koreltz et al. describe strippers for conventional finishes of the type used by applicants as an intermediate coating. Hamrock et al. do not teach and in fact teach away from waterborne overcoats. Holman et al. describe a wood floor refinishing system that is not said to be strippable and that is said to be chemically resistant. Applicants' claim 28 – 32 methods and claim 33 – 35 methods are not shown or suggested by Koreltz et al.'s conventional finish stripper, by Hamrock et al.'s system and its 100 % solids overcoat, or by Holman et al.'s chemically resistant wood floor renewal finish.

Passage of the application to the issue branch is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney if there any questions regarding this application or the Declaration.

Respectfully submitted on behalf of
Ecolab Inc.

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